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Paper No. 3

In re Application of  
Stephen Joseph McDonagh  
Application No. 60/239,469  
Filed: December 7, 1999  
Attorney Docket No. 004148.P.O.T.OFFICE OF PETITIONS FEB 23 2001  
A/C PATENTS  
DECISION GRANTING PETITION

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This is a decision on the petition under 37 CFR 1.10(e), filed February 9, 2001, requesting that the above-identified provisional application, be accorded a filing date of December 7, 1999, rather than the presently accorded filing date of October 10, 2000.

The above-identified application was first received in the Office on October 10, 2000. However, petitioner maintains that the instant provisional patent application was originally prepared and filed via Express Mail, under 37 CFR 1.10, on December 7, 1999. Petitioner contends that all requirements of 37 CFR 1.10(a) and 1.10(b) were met and that there was not reason to believe the application would not have arrived at the USPTO. In view of the petition and the attached documents, petitioner requests that the filing date for the above-referenced provisional patent application be specified as December 7, 1999. In support thereof, petitioner submitted:

- the statement under CFR 1.10(e)(4), by patent attorney Robert O'Rourke;
- a deposit certificate signed on December 7, 1999, by the individual who deposited the correspondence with the USPS;
- a "true" copy of the Express Mail mailing label number EL396332950US; and
- "true" copies of the provisional cover letter transmittal, the provisional application, the fee transmittal and the check (the originally-deposited correspondence).

Petitioner's evidence has been considered and it has been determined that petitioner has made the required showing under 1.10(e)<sup>1</sup>.

<sup>1</sup> (e) Any person mailing correspondence addressed as set out in 1.1(a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS but not received by the Office, may petition to the Commissioner to consider such correspondence filed in the Office on the USPS deposit date, provided that:

- (1) The petition is filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;
- (2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail";
- (3) The petition includes a copy of the originally deposited paper(s) or fee(s) that constitute the correspondence showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt, a copy

The declaration of patent attorney Robert O'Rourke supports a conclusion that petitioner filed the instant petition promptly within the meaning of §1.10(e)(1). The declaration shows that petitioner waited a reasonable period for return of the receipt postcard and receipt of a filing receipt. Upon discovering the lack thereof on October 10, 2000, petitioner contacted the Office; there was no record in the Office of the application being filed, although according to petitioner, numerous searches were performed using different database fields. Petitioner refiled the application, and subsequently, filed this petition.

Furthermore, the evidence establishes that the correspondence was deposited with the USPS on December 7, 1999, and should be considered filed in the Office on that date, not October 10, 2000. Specifically, the evidence reveals that:

- The "true" copy of the "Express Mail" mailing label is one of the USPS's "Post Office to Addressee" service, is addressed to the Office as set out in §1.1(a), is identified by the Express Mail mailing label number EL396332950US, bears the official USPS date stamp of "December 7, 1999, San Jose CA," and includes a "date-in" of December 7, 1999, entered by a postal employee as evidenced by the clerk's initials thereon.
- The "true" copy of the originally-filed correspondence includes the provisional application cover letter and the title page of the patent application. Both pieces of correspondence bear the "Express Mail" mailing label number EL396332950US, and the number appears to have been placed on the correspondence prior to the original mailing.
- Attorney O'Rourke, in his statement under §1.10(e)(4), attests to having submitted "true" copies of the originally mailed correspondence and to the application having been originally deposited on December 7, 1999.
- The Deposit Certificate submitted is a signed certificate created by petitioner on December 7, 1999, to certify that the referenced package was deposited on that date. It identifies the package being deposited by the docket number of the instant provisional application, by Express Mail label number EL396332950US, by the proper 1.1(a) addressee, and is signed by the depositor of the correspondence on

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of the "Express Mail" mailing label showing the "date-in," a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date other than the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS, a showing pursuant to paragraph (d)(3) of this section that the requested filing date was the date the correspondence was deposited in "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day; and

(4) The petition includes a statement which establishes, to the satisfaction of the Commissioner, the original deposit of the correspondence, and that the copies of the correspondence, the copy of the "Express Mail" mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence and original "Express Mail" mailing label, returned postcard receipt, and official notation entered by the USPS. Such statement must be a verified statement if made by a person other than a practitioner as defined in §10.1(r) of this chapter.

December 7, 1999, verifying that the deposit occurred on that date.

- Finally, petitioner's evidence is corroborated by data in the Office's USPS Express Mail Information Database, showing that the package, Express Mail number EL396332950US, was accepted by the USPS at 7:30 pm on December 7, 1999, and delivered to the Office on December 9, 1999 (copy enclosed and made of record).

In view thereof, the petition is **GRANTED**.

The application is being returned to the Office of Initial Patent Examination for correction of the filing date to December 7, 1999.

Telephone inquiries specific to this matter may be directed to Petitions Attorney Nancy Johnson at (703) 305-0309.

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Supervisory Petitions Examiner  
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Enclosure:  
USPTO's USPS Express Mail Information Database Printout